

Dear Mr. Bahr:

On behalf of the Greenblum & Bernstein Law Firm, I offer the following comments relative to the proposed rule change relative to file reconstruction:

1. The proposed rule should specify time limits for providing the necessary papers to the PTO and indicate whether they are extendable. It should not be left up to the whim of the PTO requester to set a deadline.
2. The proposed rule has no threat of any consequences against a patentee (in a patented file, as opposed to a pending application) who fails to cooperate in reconstruction of the file. To have a requirement in a rule without specifying the consequences of failure to comply with the requirement makes for an ineffective and wasted rulemaking. I suggest that, until the PTO captures electronically the papers in application files of all patents that issue, that the rulemaking simply urge compliance, for the benefit of the general public.
3. The threat of holding an application abandoned when the file is lost by the PTO is patently unfair to applicants whose applications were lost. Most pending applications fall under GATT and thus, applicants are already penalized for any time lost while the file cannot be located. Asking applicants to carry the burden of reviving their application, held abandoned for failure to provide promptly the requested copies might be fair where applicants refuse to cooperate. Most often, however, failure to cooperate will have likely resulted from having the PTO send the request for papers to reconstruct the file to the wrong address, or having not mailed them out to begin with, or there being an inadvertent failure to supply the missing papers to the PTO. In these cases, applicants would likely file a petition to withdraw the holding of abandonment or a petition to revive under the unavoidable standard. The cost of deciding these petitions would be burdensome to the PTO.

As an alternative to holding the application abandoned, I suggest that applicants who cooperate promptly (e.g., within two months of PTO notice to applicants that the file had been lost) in having the file recreated be granted patent term adjustment equivalent to the delay in prosecution resulting from the fact that the PTO lost the file. This adjustment would be reduced by a period equal to the delay beyond the "promptness" level (e.g. two months).

Thus, a utility application filed on 5/5/97 issuing on 5/5/01, where applicant took 10 months to submit the papers necessary to reconstruct the file would have its full patent term extend until 9/5/17 (20 years from filing plus 12 month term adjustment for PTO's failure to issue patent within 3 years minus 8 months (10-2) excess beyond the promptness level of 2 months in submitting the papers to have the file reconstructed equals 4 month net patent term adjustment beyond 20 years from filing).

For the handful of pre-GATT applications, i.e., utility applications with an actual filing date before June 8, 1995, the threat for failure to cooperate promptly in reconstruction of the file should be a requirement for a terminal disclaimer, disclaiming a terminal part of

any patent issued from that application, equivalent to the period of delay beyond the "prompt" standard (i.e. two months). Thus, a utility application filed in 1994, for example, and issuing on 5/5/01, where applicant took 10 months to submit the papers necessary to reconstruct the file would have its term limited by a required terminal disclaimer to extend until 9/5/17 (17 years from issuance minus 8 months (10-2) excess beyond the promptness level of 2 months in submitting the papers to have the file reconstructed equals 16 years and 4 months after issuance).

The computation for a design application, regardless of filing date, would be similar to that in the preceding paragraph, except for using 14 years for full patent term.

Thank you.

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